

## REMARKS

The Applicants have carefully studied the outstanding Office Action. The present response is intended to be fully responsive to the rejection raised by the Office and is believed to place the application in condition for allowance. Further, the Applicants do not acquiesce to any of the Office's rejections not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

### Application Status

Prior to entry of the above-listed amendment, the application included 37 claims. Of these 37 claims, claims 1, 11, 25, and 33 were in independent format. Dependent claims 2-10 ultimately depended from claim 1; dependent claims 12-24 ultimately depended from claim 11; dependent claims 26-32 ultimately depended from claim 25; and dependent claims 34-37 ultimately depended from claim 33. The Office rejected each of the 37 claims under either 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a).

In particular, the Office rejected claims 1-25, 30-33, and 36-37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,510,381 granted to Grounds et al. ("Grounds"). Further, the Office rejected claims 26-29 and 34-35 as being unpatentable over *Grounds* in view of the Office's Official Notice. In the above-listed amendment, the Applicants have cancelled claims 1-37 without prejudice, thereby making the Office's rejection moot.

After entry of the above-listed amendment, the application will include 62 claims, namely, claims 38-99. Of these, claims 38 and 89 are in independent format. Dependent claims 39-88 ultimately depend from claim 38, and dependent claims 90-99 ultimately depend from claim 89. The Applicants submit that support for the claim amendments may be found throughout the specification. Moreover, no new matter has been added.

In view of the foregoing amendment and following arguments, the Applicants respectfully submit that new claims 38-99 are allowable. Thus, the Applicants request that the application be passed to issue.

### **Claimed Invention**

The Applicants provide hereunder an aspect of the entirely claimed invention. Any difference between the explicit claim language and the following (e.g., the replacement of the word "comprising" with the word "includes") is for readability purposes, and not to limit the claimed invention.

As set forth in the preamble of claims, the claimed invention is directed to a system or method for facilitating vehicle telemetry for at least one vehicle in an application service provider environment. For example, the system of claim 28 includes an application service provider (ASP) that includes at least one server having instructions stored thereon to (i) receive from a client a request for carrying out at least one service associated with an exchange of telemetry data between the at least one vehicle and the at least one server, (ii) associate a cost for carrying out the at least one service; (iii) confirm that the client is charged a fee to cover at least the cost for carrying out the at least one service, and (iv) carry out the at least one service.

As part of the claimed invention, each new independent claim in one way or another contains one or more elements directed to facilitating vehicle telemetry for at least one vehicle in an application service provider environment. Further, each dependent claim necessarily includes all the elements of the independent claims from which it depends. Therefore, each dependent claim necessarily includes the elements directed to facilitating vehicle telemetry for at least one vehicle in an application service provider environment. The Applicants invite the Office to review each of the claims for such elements.

## Response to the Rejection under 35 U.S.C. § 102(e)

Although the Office has not examined the new claims 38-99, the Applicants submit that *Grounds* fails to teach or suggest all of the claimed elements of the claims. In particular, the Applicants submit that *Grounds* fails to teach or suggest anything remotely related to an application service provider, much less anything related to a system or method for facilitating vehicle telemetry for at least one vehicle in an application service provider (ASP) environment.

In such an environment, the ASP provides benefits over known vehicle telemetry systems and methods. For example, a single entity, such as the owner of a vehicle or fleet of vehicles, no longer needs to bear the various costs associated with facilitating a vehicle telemetry system. See the present application at page 9, paragraph 20. But rather, the costs associated with facilitating a vehicle telemetry system may be distributed among its users or clients by the ASP. See *Id.* at page 7, paragraph 16.

Moreover, the clients of the present claimed telemetry system can subscribe to portions of the system, and pay proportionate fees according to their respective usage-levels. See the present application at page 9, paragraph 20. Clients can easily change the level of their service subscription as their needs change. See *Id.* Thus, clients can easily upgrade their services if their needs increase, or they can downgrade their services if their needs decrease. See *Id.* In either situation, the clients do not have to invest in expensive fixed equipment. See *Id.*

The present application, by way of example, provides that the ASP carries out various tasks to facilitate the above-listed and unlisted benefits of a system or method for facilitating vehicle telemetry for at least one vehicle in an application service provider (ASP) environment. For example,:

"[t]he ASP 14 purchases and maintains various application-specific software packages necessary to receive, transmit, process, and store telemetry data from a vehicle 10. Further, the ASP 14 contracts for and maintains a wireless communication service 11 that facilitates wireless communication between the

telemetry module 12 of vehicle 10 and the computer server 16 of ASP 14. The ASP 14 is responsible for all of the costs associated with the installation of the on-vehicle telemetry module 12 (including hardware and software costs). The ASP 14 is further responsible for all of the costs associated with purchasing, installing, and maintaining the software necessary to receive, process, and store telemetry data. Thus, the ASP 14 preferably bears the Total Cost of Ownership of the telemetry system.

The ASP 14 allows various users 18 to access telemetry information stored on the computer server 16 for a fee. The ASP 14 may also allow the users 18 to provide adjustment/control commands to telemetry module 12, which then can download such adjustment/control commands to various electronic controllers on the vehicles 10. The users 18 may include, for example, the vehicle owner, the vehicle manufacturer, various component manufacturers, fleet managers, etc. Each of the users 18 can access all of the stored telemetry information or a subset thereof, depending upon each of the preferences of the individual users. Thus, the users 18 can elect to receive the various portions of the available information that are most useful to them.

The ASP 14 charges a fee to the users 18 to access the telemetry information received from the vehicle 10 and to send control/adjustment commands to the vehicles. The ASP 14 can devise various subscription fee arrangements, preferably based upon a system-usage level. For example, the fee for a given user can be based upon the particular type of information accessed by the user, the number of times that the user accesses information, the quantity of information accessed by the user, etc. Further, the fee structure can include one-time activation fees, a monthly base fee, etc. Many different fee arrangements are possible within the scope of this invention." See *Id.* at page 7, starting at paragraph 16, to page 8, end of paragraph 18.

The Applicants submit that, contrary to the presently claimed invention, *Gounds* fails to teach any of the above-listed various tasks facilitating vehicle telemetry for at least one vehicle in an application service provider (ASP) environment. In light of the foregoing, the Applicants submit that the claims 38-99 are not anticipated by *Grounds*, and are therefore, allowable.

### **Rejection under 35 U.S.C. § 103(a) and Response Thereto**

As noted above, the Office rejected claims 26-29 and 34-35 as being unpatentable over *Grounds* in view of the Office's Official Notice. The Office stated that, with respect to originally-filed claims 26-29 and 34-35, "Grounds does not further mention:

- (i) 'comprising the step of charging a fee to said second entity for said access to said vehicle operation information;'
- (ii) 'wherein said fee is related to system usage level corresponding to said second entity;'
- (iii) 'wherein said computer server is owned by a third entity; and
- (iv) 'wherein said computer server is maintained by a third entity."

In taking Official Notice, the Office stated "that it is known in the art that the ISP or Internet Service Provider is, of course, charging a fee for any piece of information provided by them to the user or subscribers, and the computer server [ ] eventually belongs to the ISP or owned and maintained by the host or third entity ([Grounds] col. 5/lines8-33)." The Office also stated that "[t]herefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ground's system with well-known features as claimed in order to point out that the ISP controls, maintains the computer server and is willing to charge any fee for any user requests to access the information owned by the them and related to the location or operational information of the vehicle at a distant location."

### **Challenge of Official Notice**

The Applicant respectfully challenges the taking of Official Notice. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings **will not support** an obviousness rejection) (emphasis added).

The Applicants emphatically disagree with the contention that the record contains specific factual findings and concrete evidence to support that it is known "at the time the invention was made to modify Ground's system with well-known features as claimed in order to point out that the ISP controls, maintains the computer server and is willing to charge any fee for any user requests to access to the information owned by the them and related to the location or operational information of the vehicle at a distant location." Upon review of *Grounds*, nowhere has it been shown that

- (i) an ISP charges a fee for anything, much less charging a fee for information related to the location or operational information of the vehicle at a distant location;
- (ii) the claimed computer server is owned or maintained by the ISP, a host or a third entity;
- (iii) the ISP recognizes any difference between information related to the location or operational information of the vehicle at a distant location and other information;
- (iv) the ISP owns any information related to the location or operational information of the vehicle at a distant location;
- (v) the ISP controls or maintains the computer server ... to access the information owned by the them and related to the location or operational information of the vehicle at a distant location; ; or
  - (i) the ISP is willing to charge any fee for any user requests to access the information owned by the them and related to the location or operational information of the vehicle at a distant location.

The Applicants submit that, contrary to the Office's contentions, the only specific factual findings and concrete evidence in the record is that (i) ISPs exist and (ii) *Grounds* mentions that its

device can use an ISP to access a network for connecting to a wireless phone. Specifically, *Grounds* only mention of an ISP is as follows:

"The operation of vehicle device 5 commences when the device receives power from power supply 150, which is supplied to device 5 through power cable 140. Upon receiving power, processor 60 is initialized. Processor 60 then checks for the presence and functionality of all hardware contained in device 5, and then loads the setup parameters in EEPROM 70, which include the host IP and port address, the dial string, the Internet Service Provider ("ISP") phone number, user name and password, the time and distance reporting rates for both in and out of coverage reporting, the speed trigger, the sense input trigger, and enablement and disablement triggers. Following loading of setup parameters, device 5 attempts to establish a wireless connection over wireless communication system 210 to server 230 for automatic, but intermittent, transmission of vehicle position data. A point-to-point protocol ("PPP") connection is established between second module 20 and wireless phone 110 using a packet data or circuit-switched connection depending on the wireless communications system 210. Once the PPP connection is established, vehicle position data updates are transmitted, intermittently, each time one of the configured timers, either time or distance, has expired 370. At that time, a vehicle position data update is constructed as a User Datagram Protocol ("UDP") packet and transmitted over the wireless communication system 210 to server 230." *Grounds* at col. 5, lines 8-33

The Applicants submit that, clearly, this mere mention of an ISP is not a specific factual finding or concrete evidence that supports the above-listed plurality of assertions put forth by the Office in its obviousness rejection of the claimed invention. Thus, pursuant to M.P.E.P. § 2144.03, Applicant respectfully requests that a supporting reference be cited to support Office's assertions.

Nonetheless, the Applicants submit that despite the lack of specific factual findings or concrete evidence to support the obviousness rejection, the combination of *Grounds* and the Office's Official Notice fail to establish a *prima facie* case of obviousness for the presently claimed invention. According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, (1) the proposed combination must teach or suggest all of the elements of the claimed invention, and (2) there must be some suggestion

or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

*The Proposed Combination Does Not Teach All the Elements*

The Applicants submit that neither the *Grounds* nor the Office's Official Notice expressly or impliedly teach or suggest all the elements of the new claims. Specifically, the Applicants submit that unlike the present claims, neither *Grounds* nor the Office's Official Notice, alone or combined, teach the elements of the presently claimed invention directed to a system or method for facilitating vehicle telemetry for at least one vehicle in an application service provider (ASP) environment.

The Applicants incorporate herein by reference the arguments presented under the headings "Response to the Rejection under 35 U.S.C. § 102(e)," and "Challenge of Official Notice." In light of the arguments presented above, the Applicants submit that (1) the *Grounds* does not disclose explicitly or inherently the claimed elements directed a system or method for facilitating vehicle telemetry for at least one vehicle in an application service provider (ASP) environment, and (2) the Office's Official Notice likewise fails to disclose such subject matter, the Applicants submit that these references either alone or combined, fail to disclose or suggest, all of the claimed elements. Consequently, the Applicants respectfully submit that the Office failed to raise a *prima facie* case of obviousness with respect to the new independent claims 38 and 89.

Since the dependent claims necessarily include the elements of the independent claims from which they depend, each of the dependent claims includes the above-listed elements of the independent claims from which they depend. Thus, the Applicants submit that the Office failed to raise a *prima facie* case of obviousness with respect to the dependent claims for the same reasons.

### Failure to Provide an Objective Reason to Combine References

In addition to the other requirement, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (emphasis added). See M.P.E.P. § 2143.01.

In addition, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Id.*

With respect to new independent claims 38 and 89 (and the dependent claims thereof), the Applicants respectfully submit that the Office did not provide any reference or convincing line of reasoning showing some suggestion of the desirability of doing what the Applicants have done. Instead, without providing such reference or convincing line of reasoning, the Office used impermissible hindsight and language paralleling the above-quoted language held to be insufficient to establish a *prima facie* case of obviousness to make the rejection by stating " it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ground's system with well-known features as claimed in order to point out that the ISP controls, maintains the computer server and is willing to charge any fee for any user requests to access the information

owned by the them and related to the location or operational information of the vehicle at a distant location."

The Applicants submit that no such purpose is explicitly or implicitly supported by *Gournds*. The Applicants further submit that the Office's Official Notice lacks specific factual findings or concrete evidence to explicitly or implicitly support the proffered purpose. Moreover, the Office did not show that the Office's proffered purpose provides a suggestion or motivation to combine the teachings of *Grounds* and the Office's Official Notice to produce the claimed invention.

At most, the Office's proffered purpose is a reason for applying for a patent in the first place. That is, many patentable inventions are based on the recognition that a specific combination of elements (which appear individually, but not in combination, in the prior art) will result in an improved system. Thus, because of the absence of any evidence of a motivating force, the Applicants submit that the Office failed to meet the initial burden of providing a *prima facie* case of obviousness. Consequently, the Applicants submit that the Office cannot make a *prima facie* case of obviousness based on *Grounds* and its Official Notice. The Applicants submit, therefore, that claims 38-99 are allowable.

## CONCLUSION

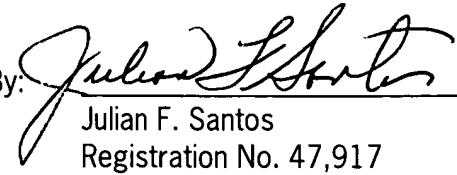
The Applicants submit that the application is in good and proper form for allowance and respectfully request the Office to pass this application to issue. If, in the opinion of the Office, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney, at 312-913-3304.

Respectfully submitted,

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